

REMARKS

Claims 1-11, 14-33 and 47-48 are pending in this Application. By this Preliminary Amendment, claims 1, 21, 22 and 33 have been amended. No new matter is added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

35 U.S.C. § 101 Rejection

The Office Action rejects claim 33 under 35 U.S.C. §101 alleging that the claimed invention is directed to non-statutory subject matter. The Applicants traverse this rejection, as follows.

The Office Action, on pages 2-3, states “a computer usable medium having control logic is directed to statutory subject matter so long as the language of the claim is not supported in the Specification with non-statutory embodiments (i.e., signals, transmission mediums and the like). See *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007) (A claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101).”

The Office Action’s interpretation of *Nuijten* is improper. Although the Court of Appeals for the Federal Circuit has held that a “signal, standing alone” is not patentable subject matter, the court was careful to distinguish claims directed to “a storage medium holding the resulting signals,” which were allowed by the PTO. See *Nuijten*, 500 F.3d 1346. Moreover, both the U.S. Supreme Court and the Court of Appeals for the Federal Circuit have declined “to adopt a broad exclusion over software or any other such category of subject matter beyond the exclusion of claims drawn to fundamental principles set forth by the Supreme Court.” See *In re Bilski*, 545 F.3d 943 (Fed. Cir.

2008), n. 21. It is submitted that claim 33 is not drawn to a “fundamental principle,” and therefore should not be summarily rejected under § 101.

It is respectfully submitted that claim 33 is directed to “a computer program product.” Further, it is submitted that a computer program product falls squarely within the statutory category of “manufacture.” Thus, is patentable subject matter under 35 U.S.C. § 101.

In addition, the Office Action, on page 3, asserts that the “Specification discloses that the computer usable medium (that includes signal bearing media) is intended to broadly encompass ‘a propagated signal on a carrier’ (Specification, page 20, lines 4-11)” and that the “claims broadly read on signals and other non tangible transmission mediums, the Examiner concludes that independent Claim 33 is directed to non-statutory subject matter.”

It is respectfully submitted that claim 33 does not recite or mention a “signal.” Claim 33 is directed to a “computer program product comprising a computer usable medium having control logic stored therein for causing a computer to provide interactive assistance with populating an automated document.” It is improper to import claim limitations from the specification. See M.P.E.P. section 2111.01. “Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into the claim when the claim language is broader than the embodiment.” See *Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870 (Fed. Cir. 2004). (Emphasis added).

Accordingly, the Applicants respectfully submit claim 33 recites statutory subject matter and request withdrawal of the rejection of claim 33.

35 U.S.C. § 103(a) Rejection

The Office Action rejects claims 1-11, 14-33 and 47-48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,270,351 to Roper in view of U.S. Patent Application Publication No. 2004/0148192 to Morley et al. (hereinafter "Morley") and further in view of U.S. Patent No. 7,398,467 to Bates et al. (hereinafter "Bates"). To the extent that these rejections remain applicable to the claims, as amended, the Applicant respectfully traverses these rejections, as follows.

Applicants submit Roper, Morley and Bates alone or in combination fail to disclose or suggest a computer-implemented method for providing interactive assistance with populating an automated document that includes at least one field, the computer comprising a processor, a data repository, and a user interface, the method including at least the following combination of features: "selecting, via the processor, an entity to which the document applies; assigning, via the processor, a prioritization to each of the at least one field, the prioritization stored in the data repository; prompting, via the user interface, for a response for each of the at least one field, the prompting varying based on the prioritization of each of the at least one field; varying, via the processor, a color of each of the at least one field based on the prioritization; performing, via the processor, a compliance check of each response for the at least one field to determine if the response complies with predetermined legal requirements, wherein a validation rule triggers the compliance check to occur as the response for the at least one field is being entered; iteratively revising, via the processor, the prioritization

of all of the at least one field upon receiving the response to each of the at least one field; prompting, via the user interface, for a response for at least one field, the prompting varying based on the iteratively revised prioritization of all of the at least one field; and displaying, via the user interface, the populated automated document," as recited in claim 1 (emphasis added).

For at least the above reasons, the Applicants submit that claim 1 is allowable over the cited references. For similar reasons, the Applicants submit that claims 21, 22 and 33 are also allowable.

As claims 1, 21, 22 and 33 are allowable, the Applicants submit that claims 2-11, 14-20, 23-32, 47 and 48, which depend from claims 1, 21 and 22, respectively, are likewise allowable over the cited references, as well as for the additional features recited therein.

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-11, 14-33 and 47-48 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number set forth below.

In the event this paper is not considered to be timely filed, the Applicant hereby petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Dkt. No. 026063-00014.

Respectfully submitted,



Tiffany J. Brooks
Registration Number 57,912

Customer Number 004372
ARENT FOX LLP
1050 Connecticut Avenue, NW, Suite 400
Washington, DC 20036-5339
Telephone: 202-857-6000
Fax: 202-638-4810

TJB/elp